



UNITED STATES PATENT AND TRADEMARK OFFICE

18c
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,450	07/27/2001	Jon C. Pergande	WG0096	8745

7590

02/26/2003

Terence P. O' Brien
Wilson Sporting Goods, Co.
8700 W. Bryn Mawr Avenue
Chicago, IL 60631

EXAMINER

DUONG, THANH P

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,450

Applicant(s)

PERGANDE ET AL.

Examiner

Tom P Duong

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 44-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 44-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-18 and 44-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakanishi et al. (4,928,972) in view of Aizawa (5,697,855).

Regarding claims 1-2, 10, and 12 Nakanishi et al. discloses an iron golf club with a front wall, a sole portion, a recess extending into the sole portion, a fiber reinforcement 5 and synthetic resin backup 6 equivalent to the resilient insert. (See Figures 5-6 and Figure 12). The claimed invention has ~~an~~ ^{the} insert only in lower region of the rear side but it appears that there is nothing unobvious about having an insert of Nakanishi extended into the upper region of the rear side to provide additional dampening affect.

Alternately, Aizawa shows a golf club head with vibration absorbing member 41 (Figure 4) in the lower region. Such configuration has the insert in the lower region which is similar to the claimed invention. Thus, it would have been obvious in view of Aizawa to one having ordinary skill in the art to shorten the Nakanishi's insert so only the insert is in the lower region of the rear side. It is inherent that the damping mechanism of Nakanishi has sufficient hardness to provide adequate shock absorption. In addition, it is obvious in view of Nakanishi and Aizawa to one having ordinary skill in the art such hardness value or any given hardness value can be obtained thru routine optimization,

In re Boesch, 205 USPQ 215 (CCPA 1980). Regarding claims 3, 4, 7, and 8, Nakanishi shows on Figure 10 the damping mechanism consist of multiple layers insert. It appears that such damping mechanism structure provides the same function and shock adsorption performance as the insert having a first and second inserts as claimed. Having a one piece-insert or insert assembly consists of a first insert and second insert is a matter of design choice to one having ordinary skill in the art. In addition, it would have been obvious to one having ordinary skill in the art to make the damping insert into plural parts such as multiple inserts assembly as a matter of obvious engineering choice. *In re Larson*, 144 USPQ 347 (CCPA 1965); *In re Lockart*, 90 USPQ 214 (CCPA 1951). Regarding claims 5 and 6, if the insert was made into plural parts like insert assembly as claimed than it would have been obvious to one of ordinary skill in the art that the insert assembly could be fabricated with the first insert material being different than the second insert material. If the first and second inserts are made of different material, than it would have been obvious that hardness of the first and second inserts are also different. Regarding claim 9, Official Notice is taken that the insert can have various shapes such as circular, elliptical, oval or polygonal and a change in shape is also an obvious matter of design choice to one skill in the art. Regarding claim 11, Aizawa teaches the insert material of the claimed invention. (Col. 4, lines 60-62). Claims 13, 14, 15, 16, 17, and 18 recite limitations similar to claims 1, 7, 8, 9, 11, and 12, respectively; thus these claims are rejected for the same reasons as described above. Claims 44-50 recite limitations similar to claims 1-18, above; thus these claims are rejected for the same reasons as described above.

Response to Arguments

Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom P Duong whose telephone number is (703) 305-4559. The examiner can normally be reached on 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on (703) 308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7768 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-4148.

Tom Duong
February 21, 2003


Paul T. Sewell
Supervisory Patent Examiner
Group 3700